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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Lopez, et al.

Appl. No. : 09/213,138

Filed : December 16, 1998

For : SYSTEM AND METHOD FOR
BROWSING AND COMPARING
PRODUCTS

Examiner : Steven R. Wasylchak

Group Art Unit 2764

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Douglas G. Muehlhauser, Reg. No. 42,018

AMENDMENT

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SEP 16 2004

Technology Center 2600

United States Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

Dear Sir:

Applicant submits this Amendment in response to the Office Action mailed March 1, 2004 (the "Office Action").

Applicant wishes to thank the Examiner for the interview conducted on July 29, 2004. During the interview, Applicant and the Examiner discussed the pending claims in the context of cited prior art. The Examiner maintained rejection of the present claims as obvious under 35 U.S.C. § 103.

In addition to the Examiner's stated view in the Office Action that Applicant is attempting to patent single screen comparison shopping, the Examiner expressed his view during the interview that Applicant is attempting to patent relational databases. Applicant respectfully disagrees as the detailed patent claims themselves soundly belie either of those views.

The present application has been on file now for over 5 years. Moreover, the Examiner has twice withdrawn all rejections to prevent Applicant's appeal of them, only to enter further rejections for obviousness. Although the Examiner has continually rejected the pending claims

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based on obviousness, the Examiner has never once made a *prima facie* case of obviousness. A review of the obviousness standard is instructive.

Under the seminal case, Graham v. John Deere, 383 U.S. 1, 17-18, 86 S.Ct. 684, 693 (1966), the determination of obviousness requires an assessment of four factors: (1) the scope and content of the prior art; (2) the differences between the subject matter of the pending claims and the prior art; (3) the level of ordinary skill in the art; and (4) any secondary considerations of non-obviousness. On the present record of this application, the last two factors, (3) and (4), have played little, if any role in the examination of Applicant's claims.¹ Therefore, any objection that the Examiner has ever made under 35 U.S.C. § 103, must be supported only by examining the differences in the prior art and the claimed invention. No combination of the prior art references of record comes close to teaching or suggesting the inventions of the pending claims. Applicant strongly submits that the differences between the prior art and the pending claims are simply the detailed limitations of the claims themselves.

Applicant urges the Examiner to reconsider the present objections, particularly since they fail to set out a *prima facie* case of obviousness under the governing standard.

¹ Applicant of course reserves its right to submit evidence of non-obviousness at its discretion.

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Amendments to the Claims are reflected in the listing of claims, which begins on page 2 of this paper.

Remarks begin on page 11 of this paper.